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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/561,692 | 12/22/2005 | Frank Stubner | ZAHFRI P786US | 8216 |
| 20210 7590 07/25/2008 DAVIS BUJOLD & Daniels, P.L.L.C. 112 PLEASANT STREET CONCORD, NH 03301 | | | EXAMINER WAITS, ALAN B | |
| | | | ART UNIT 3682 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/561,692 | Applicant(s) STUBNER, FRANK | |
| | Examiner ALAN B. WAITS | Art Unit 3682 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/22/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5-8 are written in generally narrative form making it unclear which elements/steps are being positively recited and which should be given patentable weight. The examiner suggests rewriting the claims in accordance with 37 CFR 1.75(i) so as to make clear what elements/steps are being positively recited and what should be given patentable weight. As written the claims are unclear and indefinite.

The claims are replete with indefinite language too numerous to list in their entirety. What follows are a few examples. The examiner suggests rewriting the claims to correct for the indefinite language.

Claim 5 recites the limitation "by bearings". It is unclear if these are the bearings previously recited or if they are new bearings.

Claim 5 recites the limitation "the spur gearing". It is unclear if this is the same as the "spur gear stage" recited previously in the claim or a new element.

Claims 5-8 recite the limitation "a UniPack bearing". The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the

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extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name. See MPEP 2173.05(u).

The terms "appropriately" and "close" in claim 5 are a relative terms which renders the claim indefinite. The terms "appropriately" and "close" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 5 recites the limitation "vertical bearing borings". It is unclear if these are part of the plurality of bearing borings or different bearing borings.

Claim 5 recites the limitations "the tapered pinion gear shafts", and "the bevel pinion gear shaft". There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the bearing boring". It is unclear which bearing boring this instance references.

The term "acceptable" in claim 6 is a relative term which renders the claim indefinite. The term "acceptable" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 6 recites the limitation "causes use of a shim to be redundant". It is unclear how this limits the claim. The claim does not set forth any steps involved in the

method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 7 recites the limitation "when". Use of the term "when" renders the claim unclear. The term "when" presumes an action to take place but no where previously in the claim is such action said to actually occur, or will occur. What structure allows for this function?

The term "proper" in claim 7 is a relative term which renders the claim indefinite. The term "proper" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim 7 recites the limitation "procedure safe". It is unclear what this means.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 5-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Mann et al DE 10130100.

Mann discloses a similar device comprising:

Re clm 5 and 8:

- a one-piece housing (6, fig 1)

- a bevel gearset (13, fig 1)
- a crown gear (15, fig 1)
- a plurality of bearing borings for bearings of a bevel pinion gear shaft (bearings and hole that support shaft of 13, fig 1)
- a spur gear stage (10, fig 1), which precedes the bevel gearset, and drives the pinion gear shaft (12, fig 1)
- the crown gear is supported by bearings (21, fig 1) in the housing by a UniPack bearing, and in that the housing is constructed as one-piece and fully confines the bevel gearset and the spur gearing (as shown in fig 1)
- the bevel gear transmission possesses a sealing cover (2, fig 1), which covers an opening of the housing in an area of the spur gearing (as shown in fig 1)
- the sealing cover is placed at a location, at which vertical bearing borings for the bearings of the bevel pinion gear shaft are to be made (as shown in fig 1)
- said sealing cover is provided with a circumferential protrusion (hole into which 10 fits, fig 1) [which allows an appropriately dimensioned tool to be vertically introduced into the one-piece housing for exact boring of precise, close tolerance bearing borings for the tapered pinion gear shafts]
- {the bearing boring for the bevel pinion gear shaft can be made in said housing completely in a jig}

Regarding the product by process limitation above denoted by "{ }", the examiner notes the patentability of a product does not depend on its method of production. If the

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product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Re clm 6:

- a width tolerance of the UniPack bearing is so limited, that it, together with dimensions of the crown gear falls into an acceptable tolerance window, which advantage causes use of a shim to be redundant (as shown in fig 1)

Re clm 7:

- a tolerance window of a circumferential back lash is so enlarged, that during an assembly, when consideration is given to proper tolerances, fabrication of individual components results in an assembly which is procedure safe and within limits of specified mounted dimensioning (as shown in fig 1)

Regarding the functional recitation(s) in the claim(s) above denoted by the "[]" the examiner notes while features of an apparatus may be recited either structurally or functionally, claims directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. The reference discloses all the claimed structural limitations and therefore anticipates the claim. See MPEP 2114. Additionally, the apparatus is capable of performing the claimed functions.

Double Patenting

5. Applicant is advised that should claim 5 be found allowable, claim 8 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing

one claim to object to the other as being a substantial duplicate of the allowed claim.
See MPEP § 706.03(k).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Roth et al USP 6012348 and Kawada USP 5873287 each disclose a similar device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALAN B. WAITS whose telephone number is (571)270-3664. The examiner can normally be reached on Monday through Friday 7:30 am to 5 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Alan B Waits/
Examiner, Art Unit 3682

/Richard WL Ridley/
Supervisory Patent Examiner, Art Unit 3682